

REMARKS

Favorable reconsideration and allowance of the application are respectfully requested in view of the following remarks. Claims 1-10 and 21-33 are pending. Claims 1 and 21 are independent.

ALLOWABLE SUBJECT MATTER

Applicants appreciate that the Examiner considers claims 2, 5, 8, and 10 to define allowable subject matter. *See Office Action, item 5.* Applicants note that claims 6 and 9 are not explicitly rejected in the Office Action. In the previous Office Action dated December 29, 2004, the Examiner indicates that claims 6 and 9 define allowable subject matter. Therefore, Applicants will consider that the status of claims 6 and 9 have not changed, i.e., the Examiner still considers these claims to define allowable subject matter.

OBVIOUS-TYPE DOUBLE PATENTING REJECTION – ‘728 PATENT

Claims 1, 4, 21 and 32-33 stand rejected under the judicially created doctrine of double patenting over claims 4 and 7 of a US Patent 6,908,728 (the ‘728 patent). *See Office Action, items 1-2.* Applicants respectfully disagree.

First, the Examiner alleges that independent claims 1 and 21 of the present application are not patentably distinct from claim 4 of the ‘728 patent. However, as the Examiner recognizes, the claims of the present application and

the claims of the '728 patent are not identical. The claims are not identical because the claims are directed patentably distinct inventions.

For example, independent claim 1 of the present application recites, in part "forming a cavity at an interior of the surface layer by energy of the laser beam." The Examiner alleges that the above recited feature is not patentably distinct from the feature of "irradiating a laser beam onto the emulsion layer to thereby generate air bubbles inside the emulsion layer" as recited in claim 4 of the '728 patent. In short, the Examiner is alleging that the air bubbles generated inside the emulsion layer as described in the '728 patent is the same as the cavity formed at an interior of the surface layer.

The cavity as recited in claim 1 cannot be equated with the air bubbles as recited in the '728 patent. A simple comparison of the air bubbles as illustrated in the figures of the '728 patent and the cavity as illustrated in the present disclosure clearly shows the difference. *Compare e.g. Figures 2B and 5 of the '728 patent with Figure 5A of the present disclosure; Also compare Figures 7 and 8 of the '728 patent with Figures 7 and 8 of the present disclosure.* For at least the reasons stated above, it is clear that independent claim 1 is patentably distinct from claim 4 of the '728 patent.

Independent claim 21 recites, in part "forming a cavity at an interior of the surface layer by energy of the laser beam." It is clear that claim 21 is also patentably distinct from claim 4 of the '728 patent.

The Examiner alleges that claims 32 and 33 of the present application are also not patentably distinct from claim 4 of the '728 patent. Claims 32 and 33 depend from claim 1 and 21, respectively. For at least due to the dependency thereon, claims 32-33 are patentably distinct from claim 4 of the '728 patent.

The Examiner alleges that claim 4 of the present application is not patentably distinct from claim 7 of the '728 patent. Claim 7 of the '728 patent recites "air bubbles." Clearly, claim 1 is patentably distinct from claim 7 of the '728 patent. Since claim 4 depends from claim 1, claim 4 is also patentably distinct from claim 7 of the '728 patent.

In addition, claim 7 of the '728 patent recites, "supplying a photosensitive material comprising a support having formed on at least one side thereof an emulsion layer." *Emphasis added.* Neither claim 1 nor claim 4 of the present application claims such an element. Clearly, claim 4 of the present application and claim 7 of the '728 patent do not claim a common subject matter.

Further, the Examiner alleges that claim 21 of the present application is also not patentably distinct from claim 7 of the '728 patent. But as noted above, claim 21 recites a "cavity" and claim 7 of the '728 patent recites "air bubbles." Claim 21 also does not recite the feature of supplying a photosensitive material comprising a support having formed on at least one

side thereof an emulsion layer. Claim 21 is patentably distinct from claim 7 of the '728 patent.

For at least the above stated reasons, Applicants respectfully request that the obvious-type double patenting rejection of claims 1, 4, 21 and 32-33 of the present application based on claims 4 and 7 of the '728 patent be withdrawn.

REJECTION – '728 PATENT, NAKAMURA

In the Office Action, the Examiner rejects claims 3, 7, 22-23 and 27-28 on the ground of nonstatutory obvious-type double patenting as being unpatentable over claim 4 of the '728 patent in view of Nakamura et al. (U.S. Patent No. 5,940,115). Applicants respectfully traverse.

Claims 3, 7, 22-23 and 27-28 depend from independent claims 1 and 21 directly or indirectly, and it has been shown above that independent claims 1 and 21 are patentably distinct over claim 4 of the '728 patent. Therefore, for at least due to the dependency thereon, claims 3, 7, 22-23 and 27-28 are patentably distinct over claim 4 of the '728 patent. Addition of Nakamura cannot cure this deficiency of the rejection. Therefore, claims 3, 7, 22-23 and 27-28 are patentably distinct over claim 4 of the '728 patent and Nakamura.

Applicants respectfully request that the rejection of claims 1, 3-4, 7, 21-23, and 27-28 based on the '728 patent and Nakamura be withdrawn.

REJECTION – '728 PATENT, NAKAMURA, SMART

In the Office Action, the Examiner rejects claims 24-26 and 29-31 on the ground of nonstatutory obvious-type double patenting as being unpatentable over claim 4 of the '728 patent in view of Nakamura and in further view of Smart (U.S. Patent No. 6,339,604). Applicants respectfully traverse.

Claims 24-26 and 29-31 depend from independent claims 1 and 21 directly or indirectly, and it has been shown above that independent claims 1 and 21 are patentably distinct over claim 4 of the '728 patent and Nakamura. Therefore, for at least due to the dependency thereon, claims 24-26 and 29-31 are also patentably distinct over claim 4 of the '728 patent and Nakamura. Addition of Smart cannot cure this deficiency of the rejection. Therefore, claims 24-26 and 29-31 are patentably distinct over claim 4 of the '728 patent, Nakamura and Smart.

Applicants respectfully request that the rejection of claims 24-26 and 29-31 based on the '728 patent, Nakamura and Smart be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to

be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


Respectfully submitted,

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DATE: **FEB. 15, 2006**

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